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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,448	12/03/2003	Jefferson Craig Lind	988.1045000	6733

7590 01/25/2007
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EXAMINER

MCCULLOCH JR, WILLIAM H

ART UNIT	PAPER NUMBER
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3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/726,448

Applicant(s)

LIND ET AL.

Examiner

William H. McCulloch Jr.

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to amendments filed 10/10/2006. Claims 1-23 are pending in the application, with claims 1, 8, 9, 18, and 20 currently amended. The objection to claim 8, which was detailed in the non-final rejection, is hereby withdrawn as a result of the current amendment.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Elements critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The currently amended independent claims recite associating a respective game player's game play result with a predetermined-prize bonus round, wherein the predetermined prize of the bonus round is determined by the game play result, and the game play result is determined independently of the bonus round. Part (c) requires concealing the game play result from the player until the player selects one of the selection options in the bonus game. Dependent claim 3 recites that a game comprises a bingo-type game and the game play result includes a bingo card pattern. The examiner notes that in a bingo-type game, the status of the game (e.g. how many places on the card are daubed) is constantly displayed to a player throughout the game up to and including the end of the

game. The same is true of any game that requires player participation. The examiner therefore interprets the claimed concealing of a game play result as concealing the outcome of the aggregate game (the result produced by the combination of the base and bonus games). The amended subject matter requires a game play result determined independently of the bonus round, which conflicts at least with the situation presented in above. Therefore, the examiner will interpret the claims as reciting, "wherein the predetermined prize of the bonus round is determined by the game play result", with the omission of the game play result determined independently of the bonus round. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 6, 7, 9-11, 13-15, 17-20, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 6,461,241 to Webb et al. (hereinafter Webb). This rejection was made in a previous action and is maintained herein.

Webb describes a gaming machine having a primary game and a secondary or bonus game. Webb describes the following limitations:

Regarding claims 1, 6, 10, and 20, Webb states that a secondary game can be any activity that provides a player with the opportunity to gain an award. Triggering a bonus round can provide such an opportunity. The secondary game may be a game that requires a player to align a predetermined number of markers on a grid in a particular pattern, a game that involves a player competing against the gaming device, or a game involving races and chases. See at least 1:50-2:13 and 6:64-7:15.

Regarding claims 2, 17 and 19, the bonus round is available to a player if he receives a winning predetermined outcome in a primary game. Thus if a non-winning outcome occurs, the result will inherently be a non-bonus round. The player may continue to play the primary game assuming he has an adequate amount of game credits. See at least 5:24-32.

Regarding claim 3, Webb states that the bonus game may be a bingo game. See at least 6:7.

Regarding claims 4 and 11, Webb describes an embodiment wherein the primary game is a slot machine game, which is known in the art to employ a random number generator. When a certain randomly generated outcome occurs, the player is allowed to play a bonus game. See at least 5:24-50.

Regarding claims 7, 15, 18, and 22, graphical options are presented to the player during a bonus game. The chosen options are indicated on the display screen. See at least column 6 and figures 5a-5c.

Regarding claims 9, 13, and 14, there is a network server device provided in communication with the gaming terminal(s). The terminal includes a display screen.

The processor and memory device (i.e. controller) preferably reside in the player terminal but may be embodied in the network server. See at least 4:62-5:23.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5, 8, 12, 16, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Web. This rejection was made in a previous action and is maintained herein.

Claims 8, 16, and 23 are directed toward a bonus game wherein a player is presented with a number of selection options from which to choose and is a graphical depiction of a number of participants in a contest. As described above, Webb teaches that a bonus game may be a race. Webb seems to lack specifically disclosing the fact that players may choose participants in the race. However, it was notoriously well known in the art to offer bonus games wherein a player may select one or more racers, for instance horses in a race, on which to place bets and possibly win bonus prizes. Therefore, such a limitation would have been obvious to one of ordinary skill in the art at the time of invention. The examiner offers as evidence U.S. 6,210,275 to Olsen, which discloses a horserace game where players select which horse(s) to place bets upon.

Claim 21 is directed toward associating the game play result with a bonus round in response to an event unrelated to the game play result. Claims 5 and 12 are directed

toward triggering a bonus game in response to a predetermined event. Webb seems to lack specifically disclosing the fact that events unrelated to the game play result may trigger the bonus round. However, it was notoriously well known in the art to offer bonus games wherein a bonus may be triggered by a predetermined, unrelated event. Therefore, such a limitation would have been obvious to one of ordinary skill in the art at the time of invention. The examiner offers as evidence U.S. 6,015,344 to Kelly et al., which discloses triggering a bonus event based upon the denomination of currency inserted into a gaming machine or by other promotional means.

Response to Arguments

8. Applicant's arguments filed 10/10/2006 have been fully considered but they are not persuasive.

Applicant contends on subsection (i), page 15 that the predetermined-prize bonus round is not anticipated by Webb, stating that in the claimed invention, a prize is associated with a game play result so that the prize is determined independently of the bonus round or events therein. First, the examiner disagrees that such a feature is clear from the claims presented. The currently amended claims require that the prize of the bonus round is determined by the game play result. Webb teaches such a feature as described in the rejection above. Second, applicant supports the above argument by stating that Webb requires the player to complete a plurality of steps before reaching a win condition. The examiner notes that while Webb teaches the use of multiple-step games, he also allows for any number of steps to be taken (see at least 5:54-64, 6:1-3,

6:48-52). The examiner also notes that the secondary game(s) of Webb may correspond to applicant's base game and/or bonus game.

Applicant argues in subsection (ii) that since Webb does not teach or suggest a predetermined-prize bonus round, Webb does not teach or suggest presenting the game payer with a number of selection options from which to choose during the predetermine-prize bonus round. However, the examiner has shown above that Webb teaches such. Therefore the argument is moot. Applicant further contends that Webb does not teach or suggest concealing the game play result from the game player until the player selects one of the selection options. However, it is clear from Webb that a player must input a selection into a selection-type game before the outcome of the game can be displayed. Furthermore, applicant appears to argue that the claimed invention conceals the result of a bingo-type game (as in claim 3) until a selection is made in the base game. As described in the 112 rejection above, such an argument is in conflict with the workings of a bingo-type game, since the status of the game (e.g. how many places on the card are daubed) is constantly displayed to a player throughout the game up to and including the end of the game. The examiner interprets the claimed concealing of a game play result as concealing the outcome of the aggregate game (the result produced by the combination of the base and bonus games).

In subsection (iii), applicant again points to the amended portion of the claims that requires "the predetermined prize of the bonus round is determined by the game play result and the game play result is determined independently of the bonus round." As described above, Webb anticipates such a feature.

Citation of Pertinent Prior Art

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure, and is disclosed in the attached PTO-892 form.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch Jr. whose telephone number is 571-272-2818. The examiner can normally be reached on M-F 8:30-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William H. McCulloch Jr.
Examiner
Art Unit 3714
1/18/2007

wm

A handwritten signature in black ink, appearing to read "Corbett B. Coburn", followed by a stylized flourish or checkmark.

**CORBETT B. COBURN
PRIMARY EXAMINER**